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EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09721869

Filing Date: 24 November 2000

Appellant(s): Wayne Mariner Kennard

Wayne Mariner Kennard, Esq., for the Appellant

EXAMINER'S ANSWER

This is in response to the brief filed 16 February 2005 appealing from the Office action mailed 18 August 2004.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

At three pages in length, the summary of claimed subject matter contained in the brief is not a "concise explanation" (37 CFR 41.37(c)(1)(v)), but it does accurately describe the claimed invention. Indeed, this "summary" is little more than a recitation of the claims.

(6) Grounds of Rejection to be Reviewed on Appeal

In section "VI", appellant has provided a half page of prosecution history to indirectly explain that there is one ground of rejection: Claims 1-10 are rejected under 35 U.S.C. 103(a) as obvious over Anderson et al.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Anderson et al., US 20020065723A1, 30 May 2002.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims. This is a verbatim copy of the final rejection mailed on 18 August 2004.

DETAILED ACTION***Response to Arguments***

1. Applicant's arguments filed on 24 May 2004 have been fully considered but they are not persuasive. The arguments are addressed by the following rewritten rejection and expressly at para. 6, 7 and 9 below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. Claims 1-10 are rejected under 35 U.S.C. 103(a) as obvious over Anderson et al.
4. Anderson et al. teaches (independent claims 1 and 6) a computer-based method for maximizing redemption award units in an award program ([0026]), comprising the steps of: (a) storing in the storage device (*store 140*) at least one predetermined award unit (para. [0019]); (b) storing in the storage device a shortfall amount (*the number of points needed*, (bottom of para. [0027]); (c) each program participant being permitted to accumulate a number of award units earned by performing acts for which predetermined numbers of award units will be awarded, and (d) inputting (*updates the award account*) the number of award units earned in step (c) [0020], said storing being in a *plurality of online accounts* [0005], which reads on (e) storing separately; (f) redeeming an award program award [0026], including the substeps of: (1) retrieving a predetermined award unit level to receive a particular award (*retrieves conditions to receive awards*); (2) retrieving the accumulated award unit total (*point balances*); (3, 4 and 6)¹ determining a

¹ There is no substep "5".

number of award units the that the accumulated award unit total is less than the predetermined award unit level (*the number of points needed*, [0027]); (7 and 8) determining the required amount of *AwardPoints*, which reads on a monetary amount (a *generic, convertible currency* (para. [0037] and Merriam-Webster's Online Dictionary), and redeeming the award by paying this monetary amount [0031]. Anderson et al. teaches the "multiplication factor" (substep 7) as a *ratio* used to combine *several types of award points* and convert them to *AwardPoints* (para. [0031], [0053] and [0054]).

5. Anderson et al. does not explicitly teach a shortfall percentage. However, the reference does teach *the number of points needed* [0027], which is the absolute shortfall amount. Because percentages are a common and convenient means for summarizing criteria, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Anderson et al. that the shortfall amount be expressed, stored and displayed as a shortfall percentage.
6. Applicant argues (p. 3 middle) that the reference does nothing with the shortfall. Revised para. 4 explain in detail what the reference does with the shortfall amount.
7. Applicant argues (p. 3 bottom) that the reference does not make a selection of a percentage upon which to apply the award program incentive. As noted in para 5 above, the reference does teach a criterion as an absolute shortfall amount expressed in points, not as a shortfall percentage.
8. Anderson et al. also teaches at the citations given above claims 2-4 and 7-9. The multiplication factor (*ratio*) is the same (claims 2 and 7) when dealing with only one type of point. The multiplication factor is different and weighted (claims 3-4 and 8-9) when dealing with at least two types of points.
9. Applicant argues (p. 4 top) that the reference does not teach a variety of methods for making up the (mileage) shortfall. That is not correct. The reference teaches that *several types of award points from several loyalty programs may be combined to redeem merchandise*, and that one of these types is the *AwardPoints* monetary unit.
10. Anderson et al. does not teach (claims 5 and 10) that the multiplication factor is selected based on chance. It was common, at the time of the instant invention, to use chance as a basis for incentive programs, and it is obvious to use common practices. Official

notice of this common knowledge or well known in the art statement was taken in the last Office action (Paper No. 3, mailed 24 February 2004, para. 7). This statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. (MPEP 2144.03.C.)

(10) Response to Argument

The arguments (pp. 6-10 of the brief) fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. In particular, appellant criticizes the reference (middle of brief p. 7) because it "does nothing with the shortfall". This is no claim to "doing something with the shortfall".

The shortfall is mentioned twice in the claims. Independent claim 1, step (b), claims "storing ... a shortfall percentage". Independent claim 1, step (f)(4), claims "determining ... if the ... award unit total is equal to, or greater than the shortfall percentage ... multiplied by the ... award unit level". The same limitations appear in independent claim 6, which does not differ materially from claim 1.

The rejection (para. 4 and 5) addresses these limitations as follows:

4. Anderson et al. teaches (independent claims 1 and 6) a computer-based method for maximizing redemption award units in an award program ([0026]), comprising the steps of: ... (b) storing in the storage device a shortfall amount (*the number of points needed*, (bottom of para. [0027])); ... (f) redeeming an award program award [0026], including the substeps of: ... (3, 4 and 6) determining a number of award units the that the accumulated award unit total is less than the predetermined award unit level (*the number of points needed*, [0027]);
5. Anderson et al. does not explicitly teach a shortfall percentage. However, the reference does teach *the number of points needed* [0027], which is the absolute shortfall amount. Because percentages are a common and convenient means for summarizing criteria, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Anderson et al. that the shortfall amount be expressed, stored and displayed as a shortfall percentage.

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In summary, the rejection states that the reference teaches every claim limitation dealing with a shortfall amount, which is called *the number of points needed* in the reference, and that it would be obvious to express, store and display this quantity as a shortfall percentage.

At the top of brief p. 8, appellant alleges that “the Anderson application does not in any way apply a variety of methods for making up for the mileage shortfall for award issuance.” Again, this is irrelevant because the claims are not limited to “applying a variety of methods for making up for the mileage shortfall for award issuance”. There are only two claim limitations dealing with the shortfall, and said two limitations are taught by and obvious over Anderson et al. as explained above.

The appellant makes other general allegations that the claims define a patentable invention, without specifically pointing out how the language of the claims patentably distinguishes them from the reference, at the following locations in the brief.

At pp. 8-9, appellant alleges “the Anderson application does not understand or appreciate the present application’s method of using the shortfall miles to generate novel methods to redeem awards to which the user would ordinarily not be entitled.”

At the middle para. on p. 9, appellant alleges “This is not what Appellant is covering in the scope of claims 1 and 6.”

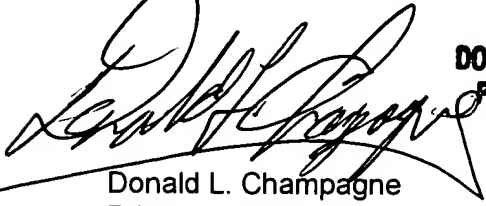
At the last para. on p. 9, appellant alleges “Further, para. [0037] fails to have any appreciation for redeeming an award based on having a shortfall, for example, of award miles and then purchasing the shortfall of miles according to the novel and non-obvious method according to the present invention.”

These arguments have little to do with the language of the claims. Applicant has ignored the claims in favor of arguing that appellant’s vision of the instant invention is distinct from the reference prior art. There is no basis in US law for patenting visions. By not specifically pointing out how the language of the claims patentably distinguishes them from the reference prior art, the appellant has provided no basis for patenting the claims.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622

Conferees:

Jeffrey D. Carlson

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